

REMARKS

The Office Action dated November 5, 2003, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto. By this Amendment, claims 1, 4, and 8 have been amended and claims 2-3 canceled without prejudice or disclaimer for filing in a continuation application. Claims 11-20 have been withdrawn from consideration as drawn to an unelected invention. No new matter has been added. Claims 1 and 4-10 are therefore pending and subject to examination.

In the Office Action, the Examiner rejected claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,995,359 to Klee, et al., in view of U.S. Patent No. 6,258,459 to Noguchi, et al. and Japanese Patent Document No. 10-189887 to Kazuhiro. The Applicants note that claims 1, 4, and 8 have been amended. To the extent that this rejection remains applicable to the claims currently pending, as amended, and subject to examination, the Applicants respectfully traverse the rejection, as follows.

The Examiner indicates in the Office Action that Noguchi is required to be included with Klee to provide "teaching that orienting the layers . . . in the same direction, for example, a (001) orientation" so as to complete the rejection. The Applicants submit that Klee does not teach forming an MgO layer on an amorphous layer. Applicants further submit that Kazuhiro does not teach or suggest forming a (001) oriented MgO layer.

The Applicants therefore submit that none of the cited prior art teaches or suggests at least the limitation of the MgO layer having a (001) orientation and being formed on the amorphous layer, as claimed in claim 1, as amended.

At least for this reason, the Applicants therefore submit that claim 1, as amended, is allowable over the cited prior art. As claim 1 is allowable, the Applicants submit that claims 4-10, which depend from allowable claim 1, are likewise allowable.

Under U.S. patent practice, the PTO has the burden under §103 to establish a prima facie case of obviousness. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *Id.* In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

The Office Action merely states that Kazuhiro shows a “related device, and provides the motivation to include additional features . . .” However, no specific motivation is cited in any of the references to evidence the desirability of combining the

references as indicated by the Examiner. It is respectfully submitted that a prima facie section 103 rejection has therefore not been established.

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition(s) for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 107317-00043.**

Respectfully submitted,



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